REMARKS

Claims 1-6, 8, 11-13, 15-20, 21-23 stand rejected under 35 U.S.C. § 103(a) as

being unpatentable over Su (U.S. Patent Number 6,219,721), hereinafter "Su". Claims

7 and 14 are rejected under 35 U .S.C. 103(a) as being unpatentable over Su (U.S.

Patent No. 6,219,721) in view of Lee (U.S. Patent No. 6,327,653). Claims 9-10, and 24

are rejected under 35 U.S.C. 103(a) as being unpatentable over Su (U.S. Patent No.

6,219.721) in view of Flanagin (U.S. Patent No. 6,128,661).

No claims have been amended, canceled or added. Reconsideration of the

present application is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1-6, 8, 11-13, 15-20, 21-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Su (U .S. Patent No. 6,219,721).

In regards to claim 1, Applicant asserts that Su does not render obvious claim 1

under 35 U.S.C. §103(a). Applicant reserves the right to swear behind the

effective prior art date of this reference. Claim 1 states:

    1. A computer system comprising:
       a first memory subsystem to store a full operating system (OS)
          and <u>a mini operating system</u>;
       a mechanical switch having a first state and a second state;
       a first circuit to execute a boot code and to determine a state of
          the mechanical switch at power-on; and
       a second circuit to boot the full OS as a primary OS of the computer
     system if the first circuit determines that the mechanical switch is in the
     first state at power-on and to boot the mini OS as the primary OS of the

computer system if the first circuit determines that the mechanical switch
is in the second state at power-on.
(Emphasis Added)

The Examiner states that:

Su does not explicitly disclose a "mini OS." However, Su mentions that
the computer has different operating systems, which are selected by a
selection switch. Furthermore, a "mini OS" can be interpreted as an older
version of an operating system which has less features and is smaller than
the new version, such as MS-DOS 4.0 or DOS 3.0, as mentioned by
Silvester (column 1 lines 25-32). Therefore it would have been obvious to
one of ordinary skill in the art at the time the invention was made to select
between an older OS version with less features (mini OS) and a newer
version of the OS (full OS) by using a mechanical switch, to avoid
reinstallation (column 1 lines 40-51).
(Office Action, page 3)

Applicant agrees with the Examiner that Su does not disclose a "mini OS", however

applicant respectfully disagrees with the Examiner that a "mini OS" can be interpreted

as an older version of an operating system. Examiner refers to MS-DOS 3.0/4.0 as an

example of a mini-OS. Applicant submits that older versions of MS-DOS would not be

considered a mini-OS. During their time of public use in the 1980s and early 1990s, MS-

DOS was considered a full featured OS and not a mini-OS. Just because they have

been replaced by newer OSes such as MS-Windows and Mac OS does not mean they

have been re-categorized from a full-featured OS to a mini-OS. They have simply been

replaced by newer full-featured OSes. If the Examiner were correct in his assessment,

than older full-featured computers running MS-DOS would be considered mini-

computers by today's standard, since they have been replaced by newer computers.

This of course is not the case. They are still full-featured computers, even if outdated.

In contrast, new hand-held devices such as a Pocket PC or Palm Tungsten run

mini-OSes such as Windows CE and Palm OS, respectively. These devices are state of

the art, yet they run a scaled down version of full operating systems. See definitions for

Windows CE and Palm OS from http://www.wikipedia.com.

Applicant submits that if, "a mini OS can be interpreted as an older version of an

operating system which has less features and is smaller than the new version", than

every version of an OS that has been replaced by a larger more feature-laden OS would

be considered a mini-OS. For example, Windows 98 could be considered a mini-OS

since it is significantly smaller and has less features than the current Windows XP. This

cannot be correct. Although Windows 98 is smaller and has fewer features than

Windows XP, it is certainly considered a full-featured OS. See definition for Windows 98

from http://www.wikipedia.com. There is still a large population of computers currently

running Windows 98. Hence the contention that a "mini OS can be interpreted as an

older version of an operating system which has less features and is smaller than the

new version" must be incorrect. See Windows XP Technical Overview,

http://www.microsoft.com, May 01, 2001.

Therefore, applicant submits that the combination of Su and the contentions that,

"a mini OS can be interpreted as an older version of an operating system which has less

features and is smaller than the new version" does not disclose each and every

limitation of claim 1. Hence, claim 1 is not made obvious under 35 U.S.C. §103(a).

Independent claims 11 and 21 also disclose a "mini-OS" as disclosed in claim 1.

For the same reasons discussed above, the combination of Su and the contentions that,

"a mini OS can be interpreted as an older version of an operating system which has less

features and is smaller than the new version" does not disclose each and every

limitation of independent claims 11 and 21. Hence, claims 11 and 21 are not made obvious under 35 U.S.C. §103(a).

Dependent claims 2-6, 8-10, 12-13, 15-20 and 22-23 depend on and include the limitations of independent claims 1, 11 and 21. Therefore, the combination of Su and the contention that, "a mini OS can be interpreted as an older version of an operating system which has less features and is smaller than the new version" do not make claims 2-6, 8-10, 12-13, 15-20 and 22-23 obvious under 35 U.S.C. §103(a).

Claims 7 and 14 are rejected under 35 U .S.C. 103(a) as being unpatentable over Su (U.S. Patent No. 6,219,721) in view of Lee (U.S. Patent No. 6,327,653).

Applicant reserves the right to swear behind the effective prior art date of Lee. As stated above, Applicant submits that Su does not disclose a "mini-OS". Applicant further submits that Lee also fails to disclose a mini-OS. In contrast, Lee only refers to a first operating system and a second operating system. Lee does not suggest that such an operating system is a mini-OS. If a reference does not discuss a limitation, then that reference cannot disclose or suggest that limitation.

Furthermore, even if Su and Lee were combined, such a combination would lack a "mini-OS." By way of contrast, the combination of Su and Lee would disclose an operating system in general or a full-featured OS.

Therefore, in view of the above distinction, neither Su nor Lee, individually or in combination, disclose each and every limitation of claims 7and 14. As such, claims 7 and 14 are not rendered obvious by Su in view of Lee under 35 U.S.C. § 103(a).

Applicant respectfully submits that Lee does not suggest a combination with Su, and Su does not suggest a combination with Lee because Lee specifically teaches away from such a combination. It would be impermissible hindsight to combine Lee with Su based on applicants' own disclosure.

Claims 9-10, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su (U.S. Patent No. 6,219.721) in view of Flanagin (U.S. Patent No. 6,128,661).

Applicant reserves the right to swear behind the effective prior art date of Flanagin. Applicant submits that the combination of Su and Flanagin do not make claims 9-10 and 24 obvious under 35 U.S.C. §103(a). Patent law requires that the evidence for the motivation to combine references under 35 U.S.C. § 103 must come from either 1) within the references themselves or 2) in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002), In re Thrift, 298 F.3d 1357, 1361 (Fed. Cir. 2002) and the Manual of Patent Examining Procedure section 2143.

The Office Action has provided inadequate motivation to combine the cited references under 35 USC § 103. The motivational reason given to combine Su and Flanagin was "to allow the user to conserve power and time if the user just needs the operating system to perform simple tasks..." (Office Action, page 8). The office action cites no hints or suggestions in either reference that actually suggests the combination of these two references. Su makes no suggestion that the disclosed operating system is a "mini-OS". Flanagin makes no suggestion that portable handheld devices using

Windows CE can be dual-booted with a full OS and a mini OS. The reasoning provided

does not make particular findings of fact as to why a person skilled in the art of

operating systems would find the suggestion to use a portable handheld device

containing Windows CE in conjunction with a computer capable of booting multiple

operating systems that are installed in different peripheral access devices. The

applicant requests a specific citing of facts to establish a prima facie case of

obviousness by a preponderance of the evidence under 35 USC § 103.

Applicant respectfully submits that Su does not suggest a combination with

Flanagin, and Flanagin does not suggest a combination with Su because Su specifically

teaches away from such a combination. It would be impermissible hindsight to combine

Flanagin with Su based on applicants' own disclosure.

Conclusion

It is respectfully submitted that in view of the amendments and remarks set forth herein, the rejections and objections have been overcome. Applicants reserve all rights with respect to the application of the doctrine equivalents. If there are any additional charges, please charge them to our Deposit Account No. 02-2666. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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